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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
007 484 838	06/07/95	FABI JANSKI	5 33229-32
			EXAMINER
18M2/0307			
FOLEY & LARDNER 3000 K STREET NW SUITE 500 P O BOX 25696 WASHINGTON DC 20007-8696			14
			1803
			DATE MAILED: 03/27/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 2/14/97
- ☒ This action is FINAL

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.
- Of the above, claim(s) 2 and 8 is/are withdrawn from consideration.
- ☒ Claim(s) 5-7 is/are allowed.
- ☒ Claim(s) 1, 3-4, 9-11 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449. Paper No(s) 11
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-4 (newly amended) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is indefinite in its recitation in part (a), lines 1-2 of "said pollen producing plant" which lacks antecedent basis in the amended claim.

Claim 4 is indefinite in its recitation in part (e), line 1 of "optionally" which contradicts the preamble of the claim, drawn to a method of producing hybrid seeds (emphasis added).

Claims 1 and 3-4, and newly submitted claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to the introduction of sense genes conferring resistance to antibiotics or herbicides, does not reasonably provide enablement for claims encompassing any gene conferring resistance to any other chemical stress or any physiological stress. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/and or use the invention commensurate in scope with these claims, as stated in the last office action for claims 1 and 3-4.

Claims 1 and 3-7, and newly submitted claims 9-11, are deemed free of the prior art for the reasons stated in the last office action for claims 1 and 3-7.

Claims 5-7 are allowed.

Applicant's arguments filed 14 February 1997 have been fully considered but they are not persuasive. Applicants urge that rejection of the claims under 35 USC 112 is improper, given the failure of the Examiner to demonstrate the unpredictability inherent in the process or the need for undue experimentation.

With regard to the unpredictability inherent in the process, the Examiner maintains that both scientific reasoning and evidence in the form of literature citations have been provided to support the Examiner's position that the identification and isolation of non-exemplified stress resistance genes, as well as their manipulation to effect male sterility, is unpredictable. Note that only scientific reasoning is required to demonstrate unpredictability and the need for undue experimentation in the unpredictable chemical and physiological arts. See In re Marzocchi & Horton, 169 USPQ 367 (at page 370, column 1, top paragraph), (CCPA 1971). See also Ex parte Hitzeman, 9 USPQ 2d 1821, 1823 (PTO Bd. App. Int. 1988), where the unpredictable physiological art was deemed to require more than one embodiment for the enablement of broad claims.

See also Ex parte Forman, 230 USPQ 546, 547 (PTO Bd. App. Int. 1986), where it was taught that "the disclosure of a patent

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application must enable practice of the invention claimed without undue experimentation", wherein factors involved in the determination of undue experimentation were deemed to include "the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims."

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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This application is subject to the provisions of Public Law 102-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or 365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a first submission and the appropriate fee of \$770 for a large entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Robinson, can be reached on Monday through Friday at (703) 308-2897.

The fax phone number for this Group is (703) 308-4227.

March 21, 1997

DAVID T. FOX
FEB 24 1997

David T. Fox